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E4  
[with] to a measuring device for the illumination and[/or] measurement of a [small volume element([) measuring volume([)] by electromagnetic radiation, and at least one connection to at least one second volume element which is in direct contact with the sample volume through an aperture and a liquid phase [wherein said aperture is preferably immediately adjacent to said measuring volume].

7.  
Add the following claim:

E5  
--67. The device of claim 59, wherein said aperture is immediately adjacent to said measuring volume.--

#### REMARKS

The claims presented for consideration are 33-63 and 65-67.

New claim 67 contains subject matter that is deleted from claim 59, in order to address one of the issues raised under the rejection based on 35 U.S.C. § 112, second paragraph. Amendments to the other claims are, also, effected in order to address the rejection under the second paragraph of § 112.

Applicants wish to thank Examiner Noland for the courteous consideration rendered to applicants' representative during an interview at the U.S. Patent and

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Trademark Office (PTO) on February 9, 1999. During the interview the matter of cited Eigen as available prior art was discussed.

Claims were rejected under 35 U.S.C. § 112, first paragraph, for allegedly lacking enablement. Reconsideration is respectfully requested.

Applicants submit that one of ordinary skill in the art possesses sufficient knowledge to practice the instant invention. PCT/EP94/00117, cited in the instant specification, exemplifies the knowledge that one of ordinary skill in the art brings to a reading of the present application. The present application provides sufficient description of the presently claimed invention such that the skilled artisan, possessing knowledge in the art (e.g., as found in PCT/EP94/00117) is enabled to make and use the invention as claimed. "In satisfying the enablement requirement, an application need not teach, and preferably omits, that which is well known in the art." *Staehelin v. Secher*, 24 USPQ2d 1513, 1516 (BPA&I 1992). "Non-critical features of the invention may be supported by a more general disclosure than those at the heart of the invention." *In re Stephens*, 188 USPQ 659, 661 (CCPA 1976).

Claims were rejected under 35 U.S.C. § 112, second paragraph, for allegedly containing indefinite claim language. In addition, thereto, the outstanding Office action identifies a number of instances where alternative claim language is suggested in order to "be in better form." Reconsideration of the rejection is respectfully requested.

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The terminology "and/or" has been deleted from the claims. The phrase "is in electrically contacts" has been changed to --electrically contacts--, and the phrase "the other environment receptor compartment" is changed, hereby, to read --a receptor compartment in the other environment--, as helpfully suggested by the examiner. The dependency of claim 55 is corrected so as to depend on claim --54--, and the term "preferably," along with subject matter following the term, is deleted from claim 59, hereby, and the subject matter deleted from claim 59 is now found in new claim 67. Additionally, corrections suggested by the examiner to "be in better form" have been incorporated into the claims by the instant Amendment. Applicants wish to thank the examiner for helpfully suggesting alternative claim language, with respect to the rejection under § 112, as well as the corrective alternative claim language.

With respect to claims 58 and 59 being "device" claims, containing reference to a "method" claim, applicants respectfully submit that this does not render claims 58 and 59 indefinite. No confusion results from referring to "claim 34" in claims 58 and 59. Claim 58 defines the device as being useful "for performing the method." Nothing confusing results from defining a "device" with reference to a "method" that the device performs; accordingly, referring to a "claim" that defines the method, rather than reciting the method, itself, creates no confusion. Moreover, referring to the preceding "method" claim as a shorthand way of defining limitations in the "device"

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claim (for example, reciting "*said* environment and *said* another environment connected by") creates no confusion.

The matter at issue with respect to claims 58 and 59 is whether *confusion* is created, not whether a "device" claim makes reference to a "method" claim. As set forth in MPEP 2173.05(f):

A claim which makes reference to a preceding claim to define a limitation is an acceptable claim construction which should not necessarily be rejected as improper or confusing under 35 U.S.C. 112, second paragraph.

Since no confusion results from referring to method claim 34 (in present claims 58 and 59, as presently amended), reference to the method claim complies with the requirements of 35 U.S.C. § 112, second paragraph.

Claims were rejected under 35 U.S.C. § 102(b) for being allegedly anticipated by Eigen. Reconsideration is respectfully requested.

As explained during the aforesaid interview with the examiner, Eigen is not available as prior art under § 102(b) of the statute. Eigen has an effective date of June 27, 1994; which date is established by the relevant issue of the periodical containing Eigen that is present in the U.S. Patent and Trademark Office library carrying the date stamp "JUN 27 1994" on its cover (copy attached, hereto). The effective date of a reference as prior art under § 102 is the date that the public

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should the next Office action contain a new rejection under § 102(a), applicants will consider submitting verified translations of the priority documents, should it be deemed appropriate.)

Claims were also rejected under 35 U.S.C. § 103 as being allegedly unpatentable based on the teachings of either Martin, Ashkin, North, Gohde or Weber. Reconsideration is respectfully requested.

According to the statement of rejection, critical reliance is placed upon certain claim limitations being *inherently* described in the cited references. Applicants respectfully submit that the rejection cannot stand because the allegations made in the statement of rejection fail to satisfy the standards necessary to demonstrate that the claim limitations are *inherently* described in the references.

"In relying on a theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teaching of the applied prior art." *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (BPA&I 1990), emphasis in original. Before "the burden shifts," the examiner has "the initial burden of establishing a prima facie basis for the alleged inherency." 17 USPQ 2d @ 1463-64. For the doctrine of inherency to apply it must be "*inevitable*" from the teachings of the prior art. *In re Wilding*, 190 USPQ 59, 62 (CCPA 1976), emphasis added. Applicants respectfully

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submit that the requisite *inevitability* has not been established for the allegedly inherent features possessed by the art relied upon in the statement of rejection.

Failure to establish obviousness is particularly evident with respect to the dependent claims. According to the statement of rejection, it is argued that the dependent claims contain

no additional features or elements not inherent or obvious from the teachings making claim 1 obvious from the above references since they appear to claim features obvious to use in, or with, such systems.

(Office action mailed January 1, 1998, page 8). With all due respect, the argument fails to support the rejection.

An argument by the PTO is "not prior art." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). When the

PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears *in the reference*. ... The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient to establish inherency. ... [S]uch a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection.

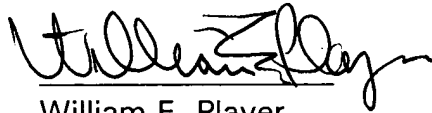
28 USPQ2d at 1557, *emphasis added*.

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Favorable action commensurate with the foregoing is requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "William E. Player", written over a horizontal line.

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